

## **REMARKS**

### **Amendment to the Title and Claims**

The title of the application has been amended to define the instantly claimed subject matter. Claims 1-46 have been canceled without prejudice to Applicants' rights to pursue the subject matter of the canceled claims in one or more related applications.

Claims 47-58 have been added. The new claims are supported by the specification and the originally filed claims. For example, claim 47 is supported by page 11, lines 3-7 and lines 12-25. Claim 48 is supported by page 7, line 8. Claim 49 is supported by page 23, lines 4-7. Claims 50-52 are supported by page 21, lines 33-34 and page 22 lines 1-3. Claim 53 is supported by page 25, line 9-11. Claim 54 is supported by page 27, lines 18-20. Claim 55 is supported by page 28, lines 18-20. Claim 56 is supported by page 28, lines 5-7. Claims 57-58 are supported by page 16, lines 29, 33 and page 21 lines 4-5. Thus, no new matter has been added.

Claims 47-58 are pending in this application. Applicants respectfully submit that the pending claims are allowable, because the objection and rejection in Office Action are moot in view of the amendment.

### **Claim Objection**

In the Office Action (page 2), the Examiner objected to claims 3 and 4 because "claim 3 is dependant in the alternative from claims 1 or 2 (2 has been restricted) and claim 4 is dependant from claim 3."

In this response, Applicants canceled claim 1-46 without prejudice and filed new claims 47-58. Accordingly, the objection is moot, and the Examiner is requested to withdraw the objection.

### **Rejection Under 35 U.S.C. 102**

In the Office Action (pages 2-3), claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by MULLER (U.S. Patent No. 5,877,200). Applicants respectfully disagree.

In this response, Applicants canceled claims 1-46 without prejudice. New claims 47-58 recite methods for treating specific diseases or disorders by administering a therapeutically or prophylactically effective amount of enantiomerically pure (+)-3-(3,4-dimethoxy-phenyl)-3-(1-oxo-1,3-dihydro-isoindol-2-yl)-propionamide, or a pharmaceutically acceptable salt or solvate thereof.

Anticipation is established under 35 U.S.C. § 102(b), when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. *Glaverbel Société Anonyme v. Northlake Mktg & Supply*, 45 F.3d 1550, 1554, 33 U.S.P.Q.2d 1496, 1498 (Fed. Cir. 1995). Muller fails to disclose each and every element of the claimed invention, because it does not teach a method for treating the recited diseases or disorders using the specific compound of the instant claims. Accordingly, the rejection is moot, and the Examiner is requested to withdraw the rejection.

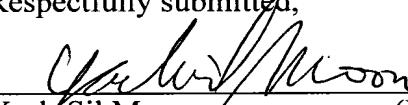
**Conclusion**

In view of the foregoing, all the rejections of the claims should be withdrawn. Reconsideration, entry of above amendment and remarks, and allowance of the pending claims are respectfully requested. Should the Examiner not agree that all claims are allowable, a personal or telephonic interview is respectfully requested to discuss any remaining issues and to accelerate the allowance of the above-identified application.

Please apply the fees for a Petition for Extension of Time (\$460.00), and any other charges or any credits to Jones Day Deposit Account No. 503013.

Respectfully submitted,

Date: January 4, 2008

  
Yeah-Sil Moon (Reg. No. 52,042)  
For: Anthony M. Insogna (Reg. No. 35,203)

**JONES DAY**  
222 East 41st Street  
New York, New York 10017  
(212) 326-3939